

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DEC 19 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER A. HOFMEISTER

Appeal No. 2003-1588
Application 09/163,844

ON BRIEF

Before KIMLIN, WARREN and PAWLIKOWSKI, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §1.196(a) (2003); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 1, Feb 2003; 1200-29 – 1200-30).

The record shows that in the communication of March 21, 2003 (Paper No. 20), the examiner considered and entered the reply brief filed February 19, 2003 (Paper No. 19), indicating that the application has been forwarded to the Board for decision on appeal (page 2).

Further in the communication of March 21, 2003 (Paper No. 20), the examiner states the “correct” ground of rejection for appealed claim 28. We note that the examiner has changed the examiner’s answer mailed December 9, 2002 (Paper No. 18) in this respect by inserting “28” in one ground of rejection and deleting “28” from two other grounds of rejection, initialing and

dating the change "03/20/03" with the notation "see paper # 20" (page 4). The examiner's answer was not remailed.

Still further in the communication of March 21, 2003 (Paper No. 20), the examiner discusses the application of Fukasawa and Bacchi with respect to a "rejection," apparently of appealed claim 28, in response to appellant's arguments in the reply brief. Indeed, no explanation of the references with respect to claim 28 was provided in the answer, and the explanation of the references is significantly different than that otherwise set forth in the answer (pages 4 and 5-6).

With respect to the mutually exclusive options available to the examiner upon the filing of a reply brief, 37 CFR § 1.193(b)(1) (2002) states in pertinent part:

The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application had been remanded by the Board of Patent Appeals and Interferences for such purposes.

This application has not been remanded for the purpose of supplying a supplemental examiner's answer in response to appellant's reply brief by any merits panel of this Board, and we do not do so here.

The examiner having both entered the reply brief and responded thereto in the communication of March 21, 2003 (Paper No. 20), we hereby remand this application to the examiner to either withdraw said communication and issue a further communication that only acknowledges receipt and entry of the reply brief, or withdraw the final rejection and reopen prosecution, as required under § 1.193(b)(1). See MPEP § 1208.03 (8th ed., Rev. 1, Feb 2003; 1200-26 – 1200-27).

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action. *See* MPEP § 708.01(D) (8th ed., Rev. 1, Feb 2003; 700-121). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.*, MPEP§ 1211 (8th ed., Rev. 1, Feb 2003; 1200-30).

Remanded

Edward (Kane)

EDWARD C. KIMLIN
Administrative Patent Judge

James E. Hansen

CHARLES F. WARREN
Administrative Patent Judge

Beverly A Pawlowski

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

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